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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re ConsulNet Computing, Inc.

Serial No. 78156904

Renee L. Mitchell of Ryley Carlock & Applewhite for
ConsulNet Computing, Inc.

Carol A. Spils, Trademark Examining Attorney, Law Office
101 (Thomas G. Howell, Managing Attorney).

Before Holtzman, Rogers, and Drost, Administrative
Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

On August 22, 2002, ConsulNet Computing, Inc.
(applicant) filed an application (No. 78156904) to register
the mark QUANTUM LEAP SUCCESS WEB SITE (typed) for services
ultimately identified as: "direct marketing advertising
for mortgage and real estate industries; developing
promotional and marketing campaigns for mortgage and real
estate industries" in Class 35. The application contains
an allegation of a date of first use and first use in

commerce of November 11, 1998, and a disclaimer of the term "web site."

The examining attorney has refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark QUANTUM LEAP (typed) for:

Providing advertising agency services to others, namely, creating, producing, and arranging for the distribution of advertising materials promoting the goods and services of others; production and distribution of television and radio commercials; and dissemination of advertising for others via an on-line electronic communications network in Class 35 and

Design of advertising and promotional computer software for others in Class 42.¹

The examining attorney argues that both marks contain the same words "Quantum Leap" and that the addition of the other terms, "Success Web Site," does not overcome the likelihood of confusion. Regarding the services, the examining attorney points out (Brief at 6) that both applicant's and registrant's "marks are used to identify advertising services." Furthermore, the examining attorney asserts that registrant's services would include "those for mortgage and real estate industries in the applicant's more specific identification." Id.

¹ Registration No. 2,353,038, issued May 30, 2000.

Applicant argues that the marks are dissimilar, that the customers are sophisticated, and that "Applicant provides different, targeted instructional and maintenance sales services to a very specific group of customers." Brief at 6.

When there is a question of likelihood of confusion, we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first address the similarities and dissimilarities of the marks QUANTUM LEAP SUCCESS WEB SITE and QUANTUM LEAP. Both marks begin with the identical words QUANTUM LEAP, which are the only words in registrant's mark. Applicant then adds the words "Success Web Site." Applicant's specimen begins with the following question:

"How can the Quantum Leap strategies that have revolutionize[d] the way you run your real estate business work even better on the Internet?" (emphasis omitted). The specimen goes on to explain that "You will have your own web site on the Internet within one week"; "You'll find out how to attract visitors to your web site"; and "we can transfer it over to your new web site."

Applicant's services are designed to attract visitors to a business's web site so the disclaimed term "web site" would not likely be used by potential purchasers to distinguish the services. "Regarding descriptive terms, this court has noted that the 'descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion.'" Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1846 (Fed. Cir. 2000), quoting, In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 752 (Fed. Cir. 1985). Disclaimed matter is often "less significant in creating the mark's commercial impression." In re Code Consultants Inc., 60 USPQ2d 1699, 1702 (TTAB 2001).

When we compare the marks QUANTUM LEAP and QUANTUM LEAP SUCCESS WEB SITE, we do not disregard the words "Success Web Site" in applicant's mark, however, that mark is dominated by the term QUANTUM LEAP, i.e., the entirety

of registrant's mark. The fact that an applicant adds an additional word or words to a registered mark does not mean that the marks are no longer similar. Wella Corp. v. California Concept Corp., 558 F.2d 1019, 194 USPQ 419, 422 (CCPA 1977) (CALIFORNIA CONCEPT and surfer design likely to be confused with CONCEPT for hair care products). Thus, neither the term "web site" nor the term "success," which suggests the positive results of using applicant's services, would sufficiently distinguish the marks.

We also do not disregard the fact that the examining attorney originally cited five other registrations that included the term "QUANTUM LEAP" owned by two different entities. The first three registrations include two for QUANTUM LEAP INNOVATIONS (Registration Nos. 2,551,643 and 2,279,276) for, inter alia, computer software for use in research, planning and strategic analysis and one for QUANTUM LEAP (No. 1,677,420) for computer software for problem solving, all owned by Quantum Leap Research, Inc. The other registrations are for QUANTUM LEAP ADVANTAGE (Nos. 2,345,904 and 2,205,082) for audio tapes, publications, and seminars on business growth and improvement owned by Great Western Development Corp. These registrations as well as other registrations referenced by applicant are for goods and services that are significantly

further removed from applicant's advertising services. Also, most of the marks in the previously cited registrations are less similar to applicant's mark than the mark in the currently cited registration. While we have considered the fact that QUANTUM LEAP is not a unique term, the evidence does not lead us to conclude that it is entitled to an extremely narrow scope of protection.

Therefore, even with applicant's additional wording, the similarities in appearance, sound, meaning, and commercial impression of the marks QUANTUM LEAP and QUANTUM LEAP SUCCESS WEB SITE would outweigh their differences.

Another key question in any likelihood of confusion analysis is the similarity or dissimilarity of the applicant's and registrant's services. Applicant's services are "direct marketing advertising for mortgage and real estate industries; developing promotional and marketing campaigns for mortgage and real estate industries." Registrant's services include creating, producing, and arranging for the distribution of advertising materials promoting the services of others; production and distribution of television and radio commercials; and dissemination of advertising for others via an on-line electronic communications network and designing software for others.

"Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods" or services. Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973). In this case, applicant has limited its direct marketing advertising, promotional, and marketing services to the mortgage and real estate industries. Registrant's services are not limited to any specific industry.² While applicant acknowledges (Brief at 8) that "Registrant is likely to advertise or promote its services and Mark in a much larger market," we note that this "much larger market" would include the mortgage and real estate industries. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983)("There is no specific limitation and nothing in the inherent nature of Squirtco's mark or goods that restricts the usage of SQUIRT for balloons to promotion of soft drinks. The Board, thus, improperly read limitations into the registration").

² Applicant argues (Brief at 7-8) that if "applicant had known that the amendment suggested by the Examining Attorney to clarify its services would be interpreted by the Examining Attorney as 'advertising agency services,' Applicant would not have agreed to amend its recitation in this manner." Applicant then requests a remand. At this late date, the request for a remand in applicant's brief does not show good cause and it is denied. TBMP § 1209.04 (2d ed. 2004). We further note that our determination that there is confusion in this case is not based on an assumption that applicant's services are necessarily advertising agency services.

Furthermore, applicant's "developing promotional and marketing campaigns" and registrant's "creating, producing, and arranging for the distribution of advertising materials promoting the goods and services of others" are very closely related, if not overlapping. One final point on the services is that applicant's specimen and the use of the term "web site" in its mark indicates that its services would include an online aspect. Similarly, registrant's services also include "the dissemination of advertising for others via an on-line electronic communications network."

Even if the services are not overlapping, "it has often been said that goods or services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is enough that goods or services are related in some manner or that circumstances surrounding their marketing are such that they would be likely to be seen by the same persons under circumstances which could give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of each parties' goods or services." In re Melville Corp., 18 USPQ2d 1386, 1388 (TTAB 1991).

Here, both applicant's and registrant's services could be encountered by the identical purchasers in the mortgage and real estate industries. Even though registrant's services are identified as advertising agency services to others and applicant's services include direct marketing advertising, potential customers seeking advertising help could explore both advertising agencies and those marketing services directly to businesses. In addition, we are unable to discern any significant differences in the channels of trade, as the services are identified in the application and registration. Therefore, the services are related and there are no significant differences in the purchasers or channels of trade to the extent that those services overlap in the mortgage and real estate industries.

Additionally, applicant argues (Brief at 9) that its purchasers are "educated professionals dealing with the details of complex real estate and mortgage transactions." The mere fact that the potential purchasers of the services of applicant and registrant may be educated or even sophisticated does not mean that there is no likelihood of confusion in this case. "Even careful purchasers are not immune from source confusion." In re Total Quality Group Inc., 51 USPQ2d 1474, 1477 (TTAB 1999). Here, we have no

evidence on the level of sophistication of the purchasers. Even if these purchasers were sophisticated when negotiating or handling real estate transactions, it is not clear how discerning these purchasers would be when purchasing advertising-related services. In this case, even sophisticated purchasers would assume that there is some relationship when the marks QUANTUM LEAP and QUANTUM LEAP SUCCESS WEB SITE are used for related advertising services. Those purchasers familiar with registrant's QUANTUM LEAP services would likely believe that applicant's QUANTUM LEAP SUCCESS WEB SITE services are a further refinement to registrant's services.

Applicant also argues that the marks have co-existed for approximately six years. However, the "lack of evidence of actual confusion carries little weight, especially in an ex parte context." Majestic Distilling, 65 USPQ2d at 1205 (citation omitted). With little or no evidence on the extent of use of the marks or the volume of sales and advertising of the marks, there is no reason to give this factor any significant weight.

After analyzing the facts of a case involving the issue of likelihood of confusion, we are required to resolve any reasonable doubts we may have in favor of the prior registrant. In re Pneumatiques, Caoutchouc

Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918, 179 USPQ 729, 729-30 (CCPA 1973); In re Hyper Shoppes (Ohio), Inc., 837 F.2d 463, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988). To the extent we have any such doubts, we resolve them in registrant's favor.

Decision: The examining attorney's refusal to register applicant's mark on the ground that it is likely to cause confusion with the cited registered mark used in connection with the identified services under Section 2(d) of the Trademark Act is affirmed.